



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Robert Parker
Serial No. : 09/364,241
Filed : July 29, 1999
Title : OSCILLATOR CONTROLLING

Art Unit : 2631
Examiner : Khanh C. Tran

Hon. Commissioner for Patents
Washington, D.C. 20231

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RESPONSE B

Dear Commissioner:

Responsive to the office action dated August 14, 2002, reconsideration of the rejection of claims is respectfully requested in the light of the following remarks and authorities.

1, 2. Claims 1-3, 4-7, 8-10, 11 and 13 stand rejected under 35 U.S.C. §102(b) as being anticipated by Ikeguchi. Regarding claims 1, 10 and 11, the reference is said to disclose in FIG. 1, col. 3, line 6 through col. 4, line 6, a preset tuner including a high frequency amplifier 2 coupled to an antenna 1 for selectively amplifying a high frequency signal transmitted by a broadcasting station; a frequency mixing for mixing the amplified high frequency signal from the high frequency amplifier 2 with a local oscillation signal for converting the high frequency signal into an intermediate frequency signal, an intermediate frequency amplifier 4 for amplifying the intermediate frequency signal from the mixer 3 and outputting to a terminal 5 for subsequent stage detecting circuit, a preset circuit 7, a voltage correcting circuit 18 comprising a frequency comparator 22 for comparing the frequency of a reference oscillator 20 with the frequency of the intermediate frequency signal from a tuner, which comprises the mixer 3 and a voltage controlled oscillator 6 to provide a correction control signal to a digital-to-analog converter 11, which controls the VCO 6 to correct any deviation of the intermediate frequency of the tuner. Regarding claims 2 and 3, the reference is said to recite some limitations of claims 2 and 3 in

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claim 1. The reference is said to further disclose the preset circuit 7 including a storage circuit 10 comprising a channel selecting switch 9, including a plurality of preset push buttons 9A, 9B, 9C ... 9N, a memory for storing a plurality of digital data representations representative of the local oscillation frequencies corresponding to the channels to be preset. Regarding claims 4-7, the function of VCO 6 is said to be to tune to a frequency within a channel frequency range by adding a frequency offset that is any frequency selected within a channel frequency range. Therefore, adding a frequency offset to the received frequency is said to be inherent, and the frequency offset it is said could be automatically an intermediate frequency of the receiver. Regarding claim 8, the reference is said to recite some limitations of claim 8 in claim 1. It is said to be inherently that the reference frequency, also known center frequency, of the channels is approximately centered in the channel frequency range. Regarding claims 9 and 13, it is said the mere selection of frequency range that is not an inventive feature could not be patentable since the preset tuner it is said could be tuned to any range of frequencies at design.

This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip

on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. *** The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. *** The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

All the rejected claims call for tuning the oscillator of the receiver to a frequency within the range of reception frequencies. Claim 1 calls for tuning the oscillator to a frequency within the range of reception frequencies based on the threshold frequency, that is less and more than the received frequency when the received frequency is above and below the threshold frequency, respectively. This feature is absent from the reference. Claims 10-12 call for the frequency controller coupled to the local oscillator and the source of a signal representative of the frequency of a desired signal to be received within the predetermined frequency range for providing a frequency control signal to the local oscillator that always sets the frequency of the local oscillator to a frequency that differs from the frequency of the desired signal by the intermediate frequency and is within the predetermined frequency range. The reference does not disclose tuning the oscillator of the receiver to a frequency within the range of reception

frequencies based on the threshold frequency that is less and more than the received frequency when the received frequency is above and below the threshold frequency, respectively. Accordingly, withdrawal of the rejection of claims 1-3, 4-7, 8-10, 11 and 13 as anticipated by the reference is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim language in the reference regarded as corresponding to each element in these rejected claims.

3. Claim 12 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Ikeguchi as the primary reference as said to be applied to claim 11 and further in view of Saito as a secondary reference. Regarding claim 12, the primary reference is said to recite some limitations of claim 12 in claim 11. Utilizing a phase-locked loop (PLL) in conjunction with a voltage-controlled oscillator is said to be well known in the art. The secondary reference is said to teach in FIGS. 1 and 5 a PLL circuit 7 that generates a tuned voltage based on a predetermined reference frequency from a frequency selection circuit 8 to control a VCO circuit 6.

This ground of rejection is respectfully traversed. We rely on the authorities set forth on pages 5 and 6 of the response filed 10 May 2002. The references must suggest the desirability of combining what is there disclosed to meet the terms of the claims being rejected.

Claim 12 is dependent upon and includes all the limitations of claim 11. We have shown above that the primary reference fails to disclose a frequency controller coupled to said local oscillator for providing a frequency controlled signal to said local oscillator that always sets the frequency of said local oscillator to a frequency that differs from that of a received signal within said predetermined frequency range by said intermediate frequency and is within said predetermined frequency range. It is thus impossible to combine the primary and secondary references to meet the terms of claim 12.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992). That is reason

enough for withdrawing the rejection of claim 12 as unpatentable over the primary and secondary references.

Accordingly, withdrawal of the rejection of claim 12 as unpatentable over the primary and secondary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to each element in at least claim 11 and quote verbatim the language in the reference regarded as suggesting the desirability of combining what is there disclosed to meet the terms of claim 12.

4. Claims 14 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ikeguchi as a primary reference as applied to claim 11 and further in view of Koyama as a secondary reference. Regarding claim 14, the primary reference is said to recite some limitations of claim 14 in claim 11, but fails to disclose a microprocessor in the frequency controller. The secondary reference is said to teach in FIG. 1 a frequency modulation (FM) receiver 1 connected to antenna 9 for receiving an audio frequency. The secondary reference is said to further disclose a microprocessor-based controller controlling the tuning of FM receiver 1 and the volume of the demodulating AF signal. It is said to be evident that a microprocessor-based controller automates and speeds up the tuning process and performs other processing skills more efficiently. Therefore, it is said it would have been obvious for one of ordinary skill to modify the primary reference tuner to include microprocessor-based frequency controller as said to be taught by the secondary reference.

Regarding claim 15, it is said using the same argument as in claims 4-7.

These grounds of rejection are respectfully traversed. Claim 14 recites a frequency controller coupled to the local oscillator for providing a frequency control signal to the local oscillator that always sets the frequency of the local oscillator to a frequency that differs from that of a received signal within the predetermined frequency range by the intermediate frequency and is within the predetermined frequency range. That limitation is absent from the primary reference. Therefore, it is impossible to combine the primary and secondary references to meet the terms of claim 14. Since claim 15 is dependent upon and includes all the limitations of claim 14, it is also impossible to combine the primary and secondary references to meet the terms of claim 15.

Accordingly, withdrawal of the rejection of claims 14 and 15 as unpatentable over the primary and secondary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to quote verbatim the language in the references regarded as corresponding to at least the elements in claim 14 and quote verbatim the language in the references regarded as suggesting the desirability of combining what is disclosed in the references to meet the terms of claims 14 and 15.

5. The courtesy of the Examiner in conducting an additional diligent search is acknowledged with appreciation. The references cited, but not applied, have been examined and are incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.

In view of the foregoing authorities, remarks and those advanced in the response filed 10 May 2002, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe this application is not in a condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps the Examiner believes are necessary to place the application in a condition for allowance.

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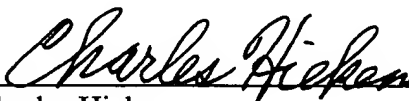
Attorney's Docket No.: 02103-349001 / AABOSS03

Enclosed is a \$410 check for the Petition for Extension of Time fee. The Commissioner is respectfully requested to apply any other charges or credits to Deposit Account No. 06-1050, Order No. 02103-349001.

Respectfully submitted,

FISH & RICHARDSON P.C.

Date: JAN 14 2003


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